

Appl. No. 10/001,654

Reply to Examiner's Action dated July 26, 2005

REMARKS/ARGUMENTS

The Applicants have carefully considered this application in connection with the Examiner's Action and respectfully request reconsideration of this application in view of the foregoing amendment and the following remarks.

The Applicants originally submitted Claims 1-40 in the application. The Applicants have not offered any amendments to the Claims with this response. Accordingly, Claims 1-40 are currently pending.

I. Formal Matters and Objections

The Applicants submit herewith a corrected ¶ 54 to correct an inadvertent typographical error.

The Examiner has objected to the drawings as failing to comply with 37 C.F.R. § 1.84(p)(5) because they include reference characters 672 and 692 not mentioned in the description. With respect to reference character 672, the Applicants have provided an amended ¶ 64 to correct the inadvertent omission of this reference character from the description. The Applicants thank the Examiner for his diligence in bringing the error to their attention.

With respect to reference character 692, the Applicants respectfully direct the Examiner to ¶ 65, which states, "...the voice packet assembler then transmits the at least one AAL2 cell to the RSP *in a step 692.*" (Emphasis added.) Because reference character 692 is supported in the written description, the Application meets the requirements of 37 C.F.R. § 1.84(p)(5) with respect to this reference character. Accordingly, no amendment is necessary.

Appl. No. 10/001,654
Reply to Examiner's Action dated July 26, 2005

Having addressed the Examiner's concerns with respect to reference characters 672 and 692, the Applicants respectfully request that the Examiner withdraw the objection to the drawings.

II. Rejection of Claims 1-5, 7-15, 17-23, 25, 27-35 and 37-40 under 35 U.S.C. § 103

The Examiner has rejected Claims 1-5, 7-15, 17-23, 25, 27-35 and 37-40 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,747,977 to Smith, *et al.* in view of U.S. Patent No. 6,075,789 to Lyons, *et al.* The Applicants respectfully traverse the Examiner's rejection of these claims because the combination of Smith and Lyons does not teach each and every element of the present invention, and further because there is no motivation to combine Smith and Lyons.

Smith addresses inefficient use of bandwidth in a packetised system by restricting the use or amount of header information sent in relation to a channel. (See Abstract.) The Examiner cites Smith for various elements of the present invention, including "a processor..., controller... and signal processor... to receive, process and convert narrowband voice data packets to broadband packets or vice-versa.... (Examiner's Action, ¶ 5.) The Examiner also cites Smith for the teaching of "a mechanism for buffering, reassembly, and retransmission of packets..." and "conversion of voice data in CPS format to ATM AAL-2 format." (*Id.*) The Examiner notes that Smith does not teach a method of parsing and reassembling a voice packet. (See *Id.*)

Lyons is concerned with extending the reserved field (RES) of an Adaptation Layer Type 2 (AAL-2) packet format for a predetermined period of time when the field width is too small for a particular application. (See Abstract; column 7, lines 39-49.) The Examiner looks to Lyons to provide additional elements of the present invention, including an AAL-2/SSCS processor and an

Appl. No. 10/001,654

Reply to Examiner's Action dated July 26, 2005

ATM processor to implement a process for segmentation and reassembly (SAR). (Examiner's Action, ¶ 5.)

However, the combination of Smith and Lyons fails to teach each and every element of the invention of independent Claims 1, 11, 21, and 31. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP ¶ 2143.03. Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." (*Id.*) Accepting for the sake of argument that the elements of Smith and Lyons cited by the Examiner are equivalent to those of the present invention, while reserving judgment on the issue, the configuration of the elements claimed in the present invention are not taught by the combination of Smith and Lyons. Specifically, independent Claim 1 claims "a voice packet processor, comprising: ...a voice packet parser configured to receive said PDUs that are ... ATM ... AAL2 cells...from said VPC ...and transmit said at least one CPS packet to said routing switch processor; and a voice packet assembler configured to receive said PDUs that are CPS Packets from said voice packet controller, assemble said CPS packets into at least one AAL2 Cell and transmit said at least one AAL2 cell to said routing switch processor." The claim not only claims the elements of a voice packet parser, a voice packet assembler and a routing switch processor, *but also claims a specific configuration of these elements.*

The configuration of elements is an additional element of the claim that must be taught or suggested in the references cited by the Examiner to make a proper *prima facie* case of obviousness. The Examiner has not cited any mention of such a configuration of elements in Smith or Lyons. The absence of the teaching or suggestion of the configuration element in the

Appl. No. 10/001,634

Reply to Examiner's Action dated July 26, 2005

Examiner's argument and the prior art renders the *prima facie* case of obviousness of Claim 1 fatally deficient, and the Claim is allowable. By similar analysis, independent Claims 11, 21, and 31 are also allowable.

The Examiner has also failed to show that there is a motivation to combine the Smith and Lyons. The Examiner may not "use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).) Moreover, the Examiner has the burden of making *specific factual findings* with respect to a motivation to combine the references. (MPEP ¶ 2143.01; 837 F.2d at 1075, 5 USPQ2d at 1600.) Furthermore, even if Smith and Lyons can be combined, while reserving judgment on the issue, the "fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness." (MPEP ¶ 2143.01.)

The Examiner's assertion of obviousness does not meet the requirements set forth by the MPEP and Federal Circuit case law. In the Action, the Examiner has recited various elements from Smith and Lyons, improperly picking and choosing these elements to assert obviousness. (See Examiner's Response, ¶ 5.) The Examiner also fails to cite *any* suggestion or motivation to combine Smith and Lyons, merely making a conclusary statement that it would be obvious to one of ordinary skill in the art to do so. (*Id.*) The Examiner utterly fails to present a specific case for why it would be obvious to combine the elements of Smith and Lyons, thereby failing to make "specific factual findings." Without more, an assertion of obviousness of Claims 1, 11, 21, and 31 over Smith and Lyons is nothing more than hindsight, which is clearly improper.

Appl. No. 10/001,654
Reply to Examiner's Action dated July 26, 2005

In view of the foregoing remarks, the present invention is not obvious over the combination of Smith and Lyons, and Claims 1, 11, 21, and 31 are allowable. Accordingly, the Applicants respectfully request that the Examiner withdraw the rejection of these claims and those claims depending therefrom.

Appl. No. 10/001,654

Reply to Examiner's Action dated July 26, 2005

III. Conclusion

In view of the foregoing amendment and remarks, the Applicants now see all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1-40.

It is not believed that any fees are due regarding this matter, however, the Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 08-2395.

The Applicants request the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application.

Respectfully submitted,

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